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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,447	03/26/2004	Su-hyun Nam	Q80019	8134
23373 7590 02/08/2008 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER HENEGHAN, MATTHEW E	
			ART UNIT 2139	PAPER NUMBER
			MAIL DATE 02/08/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/809,447

Applicant(s)

NAM ET AL.

Examiner

Matthew Heneghan

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 12-16, 18, 19, 35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) 9, 10, 35 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12-16, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/29/08</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species:

Claims 2, 4-6, 14, and 16, wherein the decrypting of a stream's content is prohibited or terminated when the first and second copy control information are different.

Claims 9, 10, 35, and 36, wherein the decrypting of a stream's content is performed according to one of the copy control information fields when the first and second copy control information are different.

The species are independent or distinct because they embody mutually exclusive processes in the event that the first and second copy control information are different.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 12 are generic.

Newly submitted claims 9, 10, 35, and 36 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The species of claim 2 et al. was presented in the original claims (e.g. original claim 1).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

prosecution on the merits. Accordingly, claims 9, 10, 35, and 36 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

2. In response to the previous office action, Applicant has amended claims 1, 2, 9, 10, 13, 14, 18, and 19; cancelled claims 11, 17, and 20-34; and added claims 35 and 36. Claims 9, 10, 35, and 36 stand as withdrawn. Claims 1-8, 12-16, 18, and 19 have been examined.

### ***Information Disclosure Statement***

3. The following Information Disclosure Statements in the instant application have been fully considered:

IDS filed 29 January 2008.

### ***Drawings***

4. The drawings were received on 30 November 2007. These drawings are acceptable.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 2, 12, 13, 18, and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 25 of copending Application No. 10/809,524. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '524 application fully anticipate the claims of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 12, 13, 16, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2001/0017828 to Yamada in view of U.S. Patent No. 4,118,789 to Casto et al.

Regarding claims 1, 2, 12, 13, 18, 19, Yamada discloses a system in which two sets of CCI information are recorded onto a medium (the DGCCI and WACCI), each of which may be used in reproducing an AV signal (see paragraph 71). A reproducing device may receive a video signal and then decrypt according to the copy control modes of the CCIs (see paragraph 88).

Yamada does not disclose that the process be contingent upon the CCI values being equal.

Casto discloses a system in which protected control instructions are read from two different locations and execution is stopped if they are not equal (see abstract), as this protects critical portions from unauthorized change (see column 1, lines 44-46).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Yamada to stop execution if the two CCI control modes are not equal, in view of Casto, to protect from unauthorized change.

Regarding claim 16, Casto discloses the displaying of an error light in the event of a mismatch (see column 14, lines 35-38), but does not specify that a message be displayed.

Official notice is given that it is well-known in the art to display error messages in error situations, in order to inform the user of the specific nature of the error.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Yamada and Casto by displaying an error message in the event of a mismatch, in order to inform the user of the specific nature of the error.

7. Claim 3-8, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2001/0017828 to Yamada in view of U.S. Patent No. 4,118,789 to Casto et al. as applied to claims 1 and 12 above, and further in view of U.S. Patent No. 7,031,942 to Ogino et al.

Regarding claims 3 and 8, Yamada only discloses control modes for copy free, copy restricted, and copy inhibited (see figure 13).

Ogino discloses analogous control modes and signals allowing for encrypted or unencrypted free copying, one-time only encrypted copying and encrypted copy inhibition (see figures 8A and 8B).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Ogino's analogous control code mapping in Yamada and Casto's invention.

Regarding claim 4, 14, and 15, Ogino discloses that the decryption key is derived from the disc key, which must be extracted from the AV stream (by the key generating unit), and the content is decrypted according to the control code (see Ogino, column 15, lines 11-30). The comparison of control codes is as per Casto.

Regarding claim 5, Ogino's decrypting signal is provided to the reproduction processing unit (see column 15, line 23), which is part of the reproducing apparatus that stores outputted signals onto a recording medium (see column 14, lines 34-63).

Regarding claim 6, the creation of the key is contingent upon the control codes (see Ogino, column 15, lines 11-14).

Regarding claim 7, Ogino's control codes are stored before usage, and Casto's modification requires a comparator.

### ***Response to Arguments***

8. Applicant's arguments filed 30 November 2007 have been fully considered but they are not persuasive.

Regarding Applicant's argument that the DGCCI and WMCCI may not both exist in all AV streams, it is not necessary for art that renders a claimed invention unpatentable to apply to all situations. The existences of a DGCCI and WMCCI in a stream in Yamada are not mutually exclusive. The two types of fields in Yamada have the same meaning, even though they are handled differently depending on which



control field is being used. They are therefore redundant and one skilled in the art would be motivated to take advantage of this redundancy as per Casto's teachings.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached at (571) 272-4063.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Matthew Heneghan/

Primary Patent Examiner, USPTO AU 2139

February 5, 2008